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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/747,936	OGG ET AL.	
	Examiner	Art Unit	
	NATHAN ERB	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,12,13,15-18 and 21-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10,12,13,15-18 and 21-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20090317*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Applicant's response to Office action was received on December 22, 2008.

3. With respect to Applicant's arguments concerning the rejections of claim 25 under 35 U.S.C. 112, second paragraph, Examiner has found Applicant's arguments to be persuasive. Therefore, those rejections are hereby withdrawn.

4. Applicant has successfully overcome the rejections of claims 8-9 under 35 U.S.C. 101 from the previous Office action by converting those claims to software claims. Therefore, those claim rejections are hereby withdrawn.

5. Applicant has successfully overcome the rejection of claim 14 under 35 U.S.C. 101 from the previous Office action by cancelling claim 14. Therefore, that claim rejection is hereby withdrawn.

6. With respect to Applicant's arguments and amendments concerning the remaining claim rejections under 35 U.S.C. 101 from the previous Office action, Applicant has not overcome those rejections for the following reasons. Claim 1, as amended, is not tied to a machine because the machine-related language is recited in the preamble, which has questionable weight with respect to patentability, as compared to the body of the claim. Regarding claim 23, Applicant points to the language of "computer-based postage system" and the displaying step as tying the claim to an apparatus. Note, however, that the "computer-based postage system" as recited in the

claim language does not actually perform any steps of the method; rather the language is used to describe the origin of the first class mail piece identifier and the authorization by the governmental postal authority to the computer-based postage provider. The step of "reporting to a display device" does indeed involve an apparatus but is simply a nominal recitation of a tie to an apparatus in the form of an output step. Regarding claims 13 and 24, Applicant maintains that these claims recite a transformation of data. However, for purposes of overcoming the rejection of these claims under 35 U.S.C. 101, the transformation that needs to be recited is a physical transformation, and the transformation of data is not considered to be such a physical transformation.

7. In order to possibly overcome the remaining rejections under 35 U.S.C. 101 from the previous Office action, Examiner suggests the following amendments. Locate the method steps that represent the key steps of the method, the essence of the invention. Then convert the action verb at the beginning of each such method step to its "infinitive" form (the "to..." form, see the example later in this paragraph). Then add the text “using a/the computer system" in front of that verb. For example, if this is done to the modifying step of claim 1, "modifying" at the beginning of the limitation would be replaced by the text "using a computer system to modify." Of course, all such changes must also be supported by the specification to be valid.

8. Please note that the amendments to the claims have caused claims 2, 4, 7, 16-18, and 21-22 to be rejected under 35 U.S.C. 101 below in this Office action.

9. Please note the new claim rejections under 35 U.S.C. 112, first paragraph, below in this Office action.

10. In response to Applicant's amendment of the claims, the corresponding claim rejections have been correspondingly amended below in this Office action.

11. Regarding the prior art rejections, Applicant argues that providing tracking of first class mail pieces in accordance with an authorization by a postal authority to the first class mail piece tracking provider for tracking first class mailings, as claimed by amended claim 1, and creating machine-readable first class mailing tracking graphic symbologies in accordance with an authorization by a postal authority, as claimed by amended claim 10, are patentably distinct from, and useful over, the computer-based postage system provider of Montgomery that provides digitally signed postage indicia to its customers which incorporates a self-styled tracking number. In support of this argument, Applicant refers to paragraph [0137] of Montgomery, which discusses how, at the time of the reference, the U.S. Postal Service only spot-checked a fraction of the postal indicia -- in contrast to Applicant's invention, in which every trackable mail piece is scanned as part of the tracking procedure. Examiner does not find this argument persuasive because, while Montgomery admits that the U.S. Postal Service does not check all indicia, Montgomery contemplates, and thus discloses, the idea of the U.S. Postal Service scanning all postal indicia (see paragraph [0137], which states: "Currently, however, the USPS only spot checks the postage indicia, and thus copy fraud may be currently difficult to detect using copy fraud--at least until the USPS scans 100% of the postage indicia.") Just because a particular disclosure is not in widespread use does not mean that it is not known. Montgomery also discusses tracking numbers being scanned 100 percent of the time (paragraphs [0032]-[0034]), as well as tracking

numbers being included on first class mail pieces in the future (paragraph [0088]); taking these two disclosures together, Montgomery discloses tracking numbers on first class mail pieces being scanned 100 percent of the time. Finally, even if not all mail pieces are scanned, the limitations of Applicant's invention at issue here would still be disclosed with respect to those mail pieces that are among the ones scanned. Therefore, Applicant's arguments are not persuasive with respect to this issue.

12. Applicant further argues that the vendor ID as described in Montgomery is distinguished from the mailing subscriber identifier in Applicant's claims because Montgomery's vendor ID does not comprise an authorization by the postal authority for tracking first class mailings that bear machine-readable tracking barcodes created in accordance with the authorization by the postal authority. Examiner disagrees. Note that in the embodiment of Montgomery referred to by Examiner in the rejection for claim 1, the unique identifiers that are used to track mail pieces are comprised of a vendor ID, a user account, and a piece count (see Montgomery, paragraph [0089]). Montgomery indicates that vendor IDs are assigned to postal vendors by the postal authority (see Montgomery, paragraphs [0103]-[0104], referring to vendor IDs under the alternative name of device IDs). If a vendor ID is required to formulate a unique tracking number under one embodiment of Montgomery, then providing a vendor with a vendor ID by a postal authority is, in fact, providing an authorization to the vendor by the postal authority to provide tracking services to a postal vendor customer. Therefore, Applicant's arguments are not persuasive with respect to this point.

13. With respect to claim 7 and related claims, Applicant again relies on the argument that its invention scans all mail pieces for tracking data, while Montgomery only scans some mail pieces for tracking data. Examiner is not persuaded, because Montgomery also discloses the possibility that all mail pieces may be scanned for tracking data. See this issue as was addressed above in this Office action.

14. Next, Applicant argues that there is no teaching or suggestion to combine Baker with Montgomery. However, immediately before making such an argument, Applicant referenced the very motivation for making the combination used by Examiner in the rejections ("Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired.") Such is the teaching, suggestion, or motivation for making the combination of Baker with Montgomery. Applicant argues that Montgomery is not directed to a mailing tracking service, yet Montgomery repeatedly discusses incorporating tracking identifiers into mail pieces. Applicant argues that Montgomery does not disclose a tracking service that is authorized by the postal authority; Examiner disagrees and addressed this issue above in this Office action.

15. Applicant next alleges that Examiner used improper hindsight in making the combinations discussed in the rejections, yet Examiner used proper rationales recognized in the MPEP for making the combinations.

16. Applicant next provides a discussion (Applicant's response, pp. 24-28) arguing that the combination of references cited by Examiner does not disclose Applicant's arrangement, wherein a "middleman" tracking provider obtains multiple subscriber

identifiers from a postal authority, then combines these subscriber identifiers with mailing identifiers, service types, and delivery address identifiers to generate tracking identifiers, each such tracking identifier uniquely associated with a mailing to be tracked of a customer of the tracking provider. Examiner disagrees. To explain, Examiner believes it will be helpful for Examiner to paraphrase the rejection for claim 1. Montgomery discloses a tracking system (which may be used for first-class mail) wherein a postal vendor assigns machine-readable information to mail pieces, including a vendor ID, a mail piece identifier, and a destination address identifier. See Montgomery, paragraph [0089], which states:

> "The standard tracking ID's 218 currently used on these USPS labels, however, are not suitable for preventing postage fraud, since one can easily duplicate the postage indicia, while using different tracking ID's 218 (perhaps on a separate label), effectively covering up the copy fraud. To facilitate in detecting fraud, the self-validating unique postage indicium 204 has been modified to include a unique identifier. As will be described in further detail below, the unique identifier can be composed of, e.g., the same tracking ID 218 that is provided at the bottom right corner of the label 200. In this case, the unique identifier contained within the self-validating unique postage indicium 204 can be used to validate the standard tracking ID 218, and can thus be relied upon to detect copy fraud in a stand-alone verification system. If a standard tracking ID 218 is not used on the label 200 (e.g., if the mail piece is being shipped via first class mail), the unique identifier can be composed of the piece count or

> ascending register in combination with the postage vendor ID and user account number. In this case, detection of copy fraud can be ensured in a stand-alone verification system only if 100% of the postage indicia are scanned. It is noted that a tracking ID provides uniqueness with a single string of numbers, whereas a postage vendor ID/user account/piece count (or ascending register) combination provides uniqueness with two strings of numbers. To this extent, the tracking ID, when available, is more advantageous to use, not only because it can detect copy fraud with respect to a single mail piece even if less than 100% of the postage indicia is scanned, but also because it can simply accomplish this with a single unique string of characters. As will be described in further detail below, however, use of the postage vendor ID/user account/piece count (or ascending register) combination as the unique identifier can be advantageously used to detect postal fraud in a non-stand-alone verification system even if 100% of the mail pieces are not scanned."

In the above paragraph, the vendor ID is a mailing subscriber ID, like that described in Applicant's claims. In Applicant's claims, the mailing subscriber ID is a code, specific to a postal vendor, which forms part of an overall mail piece identifier. The same is true for the vendor ID in Montgomery. The user account and ascending register can be regarded as a mailing identifier because they uniquely identify a mail piece with respect to a particular vendor. A destination address identifier on the mail piece is described in Montgomery, paragraph [0088], as a POSTNET bar code. While the destination address identifier in Montgomery is not necessary to uniquely identify each mail piece

(the combination of vendor ID, user account, and ascending register are already unique for each mail piece), the combination of vendor ID, user account, and ascending register is unique to each mail piece, so the combination of vendor ID, user account, ascending register, and destination address identifier (POSTNET bar code) would also be unique to each mail piece. As far as modifying elements of that combination of information fields until a unique combination is obtained, this is performed by incrementing the ascending register by one each time a new mail piece is metered for a given end user. This is equivalent to modifying the mailing identifier in Applicant's claims to result in the next unique tracking identifier.

Montgomery does not disclose service type being included in the information on the mail piece. Therefore, the combination with Baker was necessary to cover this feature of Applicant's claim 1. Baker discloses the inclusion of service type in a tracking identifier in paragraph [0020], in the form of the first two digits of a standard PLANET tracking code.

Watson was incorporated into the rejection for claim 1 to disclose wherein a plurality of mailing tracking subscriber identifiers are assigned by the postal authority to a single entity, and identifying from the plurality of mailing tracking subscriber identifiers, a next available mailing tracking subscriber identifier. Without the combination with Watson, the combination of Montgomery and Baker discloses a "middleman" postal vendor which provides machine-readable information to end users, the machine-readable information including the vendor ID, the user account, the ascending register, and the destination address identifier; with the incrementing of the ascending register

allowing for a unique combination of this information for each mail piece, the information thereby allowing for the tracking of the mail piece. The combination of Montgomery and Baker alone does not match up to such language as "recording a plurality of mailing tracking subscriber identifiers assigned by a postal authority to the first class mail piece tracking provider" in claim 1 because Montgomery does not disclose each vendor being assigned multiple vendor IDs. Therefore, Watson was needed for the disclosure of the vendor being assigned multiple subscriber identifiers (the equivalent of vendor IDs, under the above interpretation). With this combination, the remaining gap between the prior art and Applicant's claim 1 is closed.

Applicant argues that Baker has only one fixed subscriber ID per subscriber. However, note from the rejection for claim 1 and the above discussion that Baker was not used for the disclosure of multiple subscriber IDs for a vendor -- Watson was. Applicant then argues that there was no teaching or suggestion to combine Watson with Montgomery in that Montgomery is not directed to, and does not disclose, any mailing tracking service. Examiner disagrees. Montgomery repeatedly refers to “tracking ID’s” and discusses the use of such IDs for determining delivery status, a form of tracking.

Applicant next argues that the mere addition of a vendor being assigned multiple subscriber identifiers (as disclosed by Watson) does not result in Applicant's invention. Examiner believes that Applicant bases this on the fact that Watson does not disclose shifting between the multiple subscriber identifiers by a vendor until a unique tracking identifier is found. However, note that this does not necessarily happen in, for example, Applicant's claim 1, either. For example, as written in Applicant's claim 1, if the mailing

identifier is first modified, and a unique tracking identifier results, the invention would not bother modifying the subscriber identifier. The modification of the subscriber identifier until a unique tracking number is found is therefore not required by claim 1. Thus, Examiner does not consider this argument to overcome the rejections.

17. Applicant next discusses the various advantages of Applicant's invention in that it improves over the CONFIRM® service by allowing for mailpiece-specific tracking. Examiner responds that the combination of Montgomery, Baker, and Watson described above also results in tracking information unique to each mailpiece. Applicant also discusses the value of Applicant's invention to low-volume mailers, which Examiner does not necessarily dispute. However, this does not overcome the fact that the combination of references discussed above results in Applicant's claimed invention.

18. Applicant next argues that the combination of Leon with Montgomery was improper because neither Leon nor Montgomery is directed to any mailing tracking service. Applicant disputed this argument with respect to Montgomery above in this Office action. With respect to Leon, Examiner also disputes the argument that Leon does not disclose any mailing tracking service (see, for example, the title of Leon: "Techniques for Tracking Mailpieces and Accounting for Postage Payment").

19. Applicant next alleges that Examiner used improper hindsight in making the combination of Montgomery and Leon discussed in the rejections, yet Examiner used proper rationales recognized in the MPEP for making the combinations.

20. Applicant next asserts that the combination of Montgomery and Leon does not disclose the limitation Applicant discusses in the first paragraph of p. 30 of Applicant's

response, but does not explain why Examiner's rejections are insufficient specifically. Therefore, Examiner stands by the rejections in this Office action with respect to this argument.

21. Applicant next argues that the combination of Denman with Montgomery was improper because neither Denman nor Montgomery is directed to any mailing tracking service. Applicant disputed this argument with respect to Montgomery above in this Office action. With respect to Denman, Examiner notes that the limitation of claim 6, for which Denman was used, was not a tracking-specific limitation.

22. Applicant next alleges that Examiner used improper hindsight in making the combination of Montgomery and Denman discussed in the rejections, yet Examiner used proper rationales recognized in the MPEP for making the combinations.

Claim Rejections - 35 USC § 112

23. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

24. Claims 4, 8-9, and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, after reviewing Applicant's specification, Examiner was unable to find support for the following limitations:

a. Claim 4: "for an electronic mail piece tracking identifier for which no match is found, reporting to the particular user an indication that there is no tracking information available for the particular first class mail piece."

b. Claim 8 (and claim 9 via dependency on claim 8): "A computer program product, comprising a computer-readable medium having a computer-readable program code embodied therein, said computer-readable program code adapted to be executed to implement a method for printably rendering a trackable mail piece identifier graphic symbology, said method comprising:"

c. Claim 26: "for a tracking identifier for which no match is found, indicating to the particular customer user that tracking status information was not found for the particular first class mail piece."

Claim Rejections - 35 USC § 101

25. Claims 1-2, 4-7, 13, 15-18, and 21-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-2, 4-7, 13, 15-18, and 21-25 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes should positively recite the other statutory class to which they are tied (e.g., by identifying the apparatus that accomplishes the method steps), or positively recite the subject matter that is being

transformed (e.g., by identifying the product or material that is changed to a different state). Claims 1-2, 4-7, 13, 15-18, and 21-25 identify neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

26. Claims 10, 12, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Montgomery et al., U.S. Patent Application Publication No. US 2003/0101143 A1

As per **Claim 10**, Montgomery et al. discloses:

- a method of encoding a trackable first class mail piece identifier as a graphic symbology (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces);

- receiving a request by a particular customer user of a plurality of customer users of a computer-based postage provider to print computer-based postage for a particular first class mail piece for mailing the particular first class mail piece to a particular delivery address, wherein the request to print computer-based postage comprises an indication by the particular customer user to track the particular first class mail piece (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; users request postal indicia from postal vendors; invention may be applied to first class mail pieces);

- assigning a tracking identifier to correspond to the particular customer user and to trackably correspond to the particular first class mail piece, wherein the tracking identifier trackably identifies the particular first class mail piece during a particular period of time, wherein the tracking identifier comprises a mailing subscriber identifier corresponding to an authorization to the computer-based postage provider by a postal authority for the computer-based postage provider to create machine-readable first class mailing tracking graphic symbologies in accordance with the authorization by the postal authority, a mailing identifier, and a delivery address identifier, wherein the delivery address identifier is trackably unique within a combination of the mailing subscriber identifier and the mailing identifier during a period of time, and wherein the mailing subscriber identifier corresponds to an authorization by the postal authority for tracking first class mailings by the computer-based postage provider (Figures 19 and 22; paragraph [0004]; paragraphs [0024]-[0025]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; may include POSTNET bar code, which identifies delivery address);

- encoding the tracking identifier as a machine-readable graphic symbology in accordance with the authorization by the postal authority, said machine-readable graphic symbology adapted for fixing in a visual medium that is adapted for physical

association with the particular first class mail piece (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]);

- saving in a memory storage a relationship between the tracking identifier and the particular customer user (paragraph [0089]; paragraphs [0190]-[0194]; user account number that is part of the tracking ID identifies a particular user).

As per **Claim 12**, Montgomery et al. further discloses wherein encoding the tracking identifier as a graphic symbology comprises encoding the tracking identifier as a machine-readable bar code (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 18**, Montgomery et al. discloses:

- a method using a computer-based postage system for printing a trackable first class mail piece identifier for a first class mail piece (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces; system uses computers);

- generating for printing on a remote printer in communication with a remote client computer, computer-based postage indicia for a particular first class mail piece in accordance with a postage printing request by a particular customer user of a plurality

of customer users of the computer-based postage system, wherein the postage printing request comprises a delivery address (paragraph [0096]; paragraph [0133]);

- generating a first class mail piece tracking identifier for the particular first class mail piece, wherein the first class mail piece tracking identifier comprises: a mailing subscriber identifier corresponding to an authorization by a governmental postal authority to a computer-based postage provider associated with the computer-based postage system, to create for customer users of the computer-based postage system, machine-readable, graphic symbologies for tracking first class mail pieces, a mailing identifier, and a delivery address identifier corresponding to the delivery address, wherein the delivery address is trackably unique within a combination of the mailing subscriber identifier and the mailing identifier during a particular period of time (paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0095]; paragraph [0104]; vendor ID [described as possibly part of a "Device ID"] is assigned by USPS; tracking provider is a postal vendor; mailing identifier is user account number plus piece count [or ascending register]; mailing subscriber identifier is vendor ID; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking);

- encoding the first class mail piece tracking identifier as a machine-readable barcode (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]);

- storing a set of information relating the first class mail piece tracking identifier to the particular customer user (paragraph [0089]; paragraphs [0190]-[0194]; user account number that is part of the tracking ID identifies a particular user);

- generating for printing a printable format of the machine-readable barcode (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

Claim Rejections - 35 USC § 103

27. Claims 1-3, 5, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al., U.S. Patent Application Publication No. US 2004/0215478 A1, in further view of Watson, Neva, "Changes to the Domestic Mail Manual to Implement Confirm (R) -- Service," 67 FR 53454, August 15, 2002.

As per **Claim 1**, Montgomery et al. discloses:

- a computer-implemented method for a first class mail piece tracking provider to provide, to a plurality of customers of the first class mail piece tracking provider, tracking of individual outbound first class mail pieces respectively initiated in a mail stream by respective customers of the plurality of customers, said method implemented using a computer-based postage system programmed for operation on behalf of the first class mail piece tracking provider, said computer-based postage system available for communication with each respective customer of the plurality of customers, said method comprising the computer-based postage system programmed (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0168]; paragraph [0183]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention

may be applied to first class mail pieces; tracking provider is a postal vendor; system uses computers);

- recording a mailing tracking subscriber identifier assigned by a postal authority to the first class mail piece tracking provider, the mailing tracking subscriber identifier corresponding to an authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings that bear machine-readable tracking barcodes created in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings (Figures 19 and 22; paragraphs [0033]-[0035]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0104]; mailing subscriber identifier is vendor ID; vendor ID [described as possibly part of a “Device ID”] is assigned by USPS; tracking provider is a postal vendor);

- receiving, from a particular customer of the plurality of customers of the first class mail piece tracking provider, a request to mail a particular first class mail piece to a delivery address, wherein the request from the particular customer to mail the particular first class mail piece comprises an indication by the particular customer to provide tracking of the particular first class mail piece (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; users request postal indicia from postal vendors; postal indicia contain tracking IDs; request is thus at least an implicit indication by user to provide tracking; invention may be applied to first class mail pieces);

- determining a delivery address identifier corresponding to the delivery address (paragraph [0004]; paragraphs [0087]-[0088]; may include POSTNET bar code, which identifies delivery address);

- identifying a next available mailing tracking identifier (paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; mailing identifier is user account number plus piece count [or ascending register]);

- modifying at least one of the next available mailing tracking subscriber identifier and the next available mailing identifier, until determining a combination of a destination tracking service type, the next available mailing tracking subscriber identifier, the next available mailing identifier, and the delivery address identifier corresponding to the delivery address, to comprise a first class mail piece tracking identifier that would trackably identify the particular first class mail piece during a particular period of time in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings (paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; mailing identifier is user account number plus piece count [or ascending register]; mailing subscriber identifier is vendor ID; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; taking the ascending register would always result in a new unique combination in this new environment, thereby fulfilling this condition and not needing to consider any further combinations);

- assigning the first class mail piece tracking identifier to the particular first class mail piece, wherein the first class mail piece tracking identifier trackably identifies the particular first class mail piece during the particular period of time (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; invention may be applied to first class mail pieces; mailing

subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking);

- relating the first class mail piece tracking identifier to the particular customer of the plurality of customers (paragraph [0089]; paragraphs [0090]-[0093]; account number in vendor ID plus user account number plus piece count [or ascending register] relates the mail piece to a user).

Montgomery et al. fails to disclose wherein the tracking identifier includes the destination tracking service type. Baker et al. discloses wherein the tracking identifier includes the destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the tracking identifier includes the destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

Montgomery et al. and Baker et al. fail to disclose wherein a plurality of mailing tracking subscriber identifiers are assigned by the postal authority to a single entity, and identifying from the plurality of mailing tracking subscriber identifiers, a next available mailing tracking subscriber identifier. Watson discloses wherein a plurality of mailing

tracking subscriber identifiers are assigned by the postal authority to a single entity, and identifying from the plurality of mailing tracking subscriber identifiers, a next available mailing tracking subscriber identifier (p. 3, section A; p. 6, section B; p. 9, section C; using a plurality of mailing subscriber identifiers would require that a subscriber be able to choose which one to use for the next destination confirm mailing). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply a matter of allowing a vendor in Montgomery et al. to distribute tracking numbers using more than one different vendor ID; everything would operate the same for different vendor numbers, other than the vendor numbers themselves being different; associating additional vendor IDs with a single vendor can be done simply by adding the additional vendor IDs to a computer file which includes such information about the vendor). In combination, each element merely would have performed the same function as it did separately (again, Montgomery et al.'s tracking system would operate the same for different vendor IDs for the same vendor, with the exception that the vendor IDs themselves would be different; changing the vendor ID would not interfere with being able to indicate the destination tracking service type in the tracking identifier, as in Baker et al.; having multiple vendor/subscriber IDs would still serve the function that they do in Watson, allowing the tracking of more mailpieces). One of ordinary skill in the art would have recognized that the results of the combination were predictable (this is simply substituting one arbitrary ID number in place of another arbitrary ID number, as part of a tracking number; since the vendor numbers

themselves could be any values, as long as they are each associated with a single vendor, the system of Montgomery et al. should be expected to function quite the same as vendor IDs are varied for a given vendor). Thus, the combination would have been obvious.

As per **Claim 2**, Montgomery et al. further discloses said method further comprising: encoding the first class mail piece tracking identifier as a graphic symbology adapted for fixing in a visual medium, said visual medium adapted for physical association with the particular first class mail piece (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 3**, Montgomery et al. further discloses said method further comprising: physically associating the graphic symbology fixed in the visual medium with the particular first class mail piece (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 5**, Montgomery et al. fails to disclose wherein the mail piece tracking identifier further comprises: a service type. Baker et al. further discloses wherein the mail piece tracking identifier further comprises: a service type (paragraph [0002]; paragraph [0020]; paragraph [0028]). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. as modified in the rejection for claim 1 such that the mail piece

tracking identifier further comprises: a service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

As per **Claim 7**, Montgomery et al. further discloses the method further comprising: encoding the first class mail piece tracking identifier as a machine-readable bar code; and formatting the machine-readable bar code for print rendering as a label for the particular first class mail piece (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]).

As per **Claim 8**, Montgomery et al. discloses:

- a computer program product, comprising a computer-readable medium having a computer-readable program code embodied therein, said computer-readable program code adapted to be executed to implement a method for printably rendering a trackable mail piece identifier graphic symbology (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0095]-[0098]; paragraph [0146]);

- encoding a mailing subscriber identifier corresponding to a mailing subscriber identifier assigned by a postal authority to a first class mail piece tracking provider, wherein each mailing subscriber identifier corresponds to an authorization to the first class mail piece tracking provider by the postal authority for tracking first class mailings that bear machine-readable tracking barcodes created in accordance with the

authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0104]; mailing subscriber identifier is vendor ID; vendor ID [described as possibly part of a "Device ID"] is assigned by USPS; tracking provider is a postal vendor);

- encoding a mailing identifier as an encoded mailing identifier, the encoded mailing identifier comprising an encoding of a mailing identifier corresponding to a particular customer user of a plurality of customer users of the first class mail piece tracking provider (Figure 19; paragraphs [0024]-[0025]; paragraph [0089]; paragraphs [0090]-[0093]; mailing identifier is user account number plus piece count [or ascending register]; mailing subscriber identifier is vendor ID; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking);

- encoding a delivery address identifier corresponding to a delivery address to which the particular customer user has requested destination tracking of a particular first class mail piece, wherein a combination of the encoded mailing subscriber identifier, the encoded mailing identifier, and the encoded delivery address identifier corresponding to the delivery address, comprises a first class mail piece tracking identifier that trackably identifies the particular first class mail piece during a particular period of time in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings and that is associated with the particular customer user (Figures 19 and 22; paragraph [0004]; paragraph [0032];

paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; may include POSTNET bar code, which identifies delivery address).

Montgomery et al. fails to disclose encoding a destination tracking service type. Baker et al. discloses encoding a destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that it encodes a destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

Montgomery et al. fails to disclose wherein the tracking identifier includes the encoded destination tracking service type. Baker et al. further discloses wherein the tracking identifier includes the encoded destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. as modified above in this rejection such that the tracking identifier includes the encoded destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that

the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

Montgomery et al. and Baker et al. fail to disclose wherein a plurality of mailing subscriber identifiers are assigned by the postal authority to a single entity. Watson discloses wherein a plurality of mailing subscriber identifiers are assigned by the postal authority to a single entity (p. 3, section A; p. 6, section B; p. 9, section C; using a plurality of mailing subscriber identifiers would require that a subscriber be able to choose which one to use for the next destination confirm mailing). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply a matter of allowing a vendor in Montgomery et al. to distribute tracking numbers using more than one different vendor ID; everything would operate the same for different vendor numbers, other than the vendor numbers themselves being different; associating additional vendor IDs with a single vendor can be done simply by adding the additional vendor IDs to a computer file which includes such information about the vendor). In combination, each element merely would have performed the same function as it did separately (again, Montgomery et al.'s tracking system would operate the same for different vendor IDs for the same vendor, with the exception that the vendor IDs themselves would be different; changing the vendor ID would not interfere with being able to indicate the destination tracking service type in the tracking identifier, as in Baker et al.; having multiple vendor/subscriber IDs would still serve the function that they do in Watson, allowing the tracking of more mailpieces). One of

ordinary skill in the art would have recognized that the results of the combination were predictable (this is simply substituting one arbitrary ID number in place of another arbitrary ID number, as part of a tracking number; since the vendor numbers themselves could be any values, as long as they are each associated with a single vendor, the system of Montgomery et al. should be expected to function quite the same as vendor IDs are varied for a given vendor). Thus, the combination would have been obvious.

As per **Claim 9**, Montgomery et al. further discloses said method further comprising: wherein the delivery address identifier is trackably unique during a particular period of time, within a combination the encoded mailing subscriber identifier and the encoded mailing identifier (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]).

Montgomery et al. fails to disclose encoding a service type identifier. Baker et al. further discloses encoding a service type identifier (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. as modified in the rejection for claim 8 such that it encodes a service type identifier, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

28. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al. in further view of Watson in further view of Leon, U.S. Patent No. 7,069,253 B2.

As per **Claim 4**, Montgomery et al. further discloses said method further comprising: accessing a plurality of electronic mail piece tracking identifier representations, presented by the postal authority, each electronic mail piece tracking identifier representation of the plurality of electronic mail piece tracking identifier representations corresponding to one scanned first class mail piece tracking identifier of a plurality of scanned first class mail piece tracking identifiers produced in accordance with the authorization by the postal authority to the first class mail piece tracking provider for tracking first class mailings; searching the plurality of electronic mail piece tracking identifier representations for an electronic mail piece tracking identifier that matches the first class mail piece tracking identifier that trackably identifies the particular first class mail piece (Figures 19 and 22; paragraphs [0087]-[0088]; paragraphs [0190]-[0194]).

Montgomery et al., Baker et al., and Watson fail to disclose a postal services vendor receiving from the particular user a request for tracking information regarding the particular first class mail piece and, for an electronic mail piece tracking identifier that matches the first class mail piece tracking identifier that trackably identifies the particular first class mail piece, reporting to the particular user, tracking information associated with the electronic mail piece tracking identifier. Leon discloses a postal

services vendor receiving from the particular user a request for tracking information regarding the particular first class mail piece and, for an electronic mail piece tracking identifier that matches the first class mail piece tracking identifier that trackably identifies the particular first class mail piece, reporting to the particular user, tracking information associated with the electronic mail piece tracking identifier (Figure 1; column 4, lines 1-55; column 8, lines 21-43; column 14, lines 26-47; column 21, line 19, through column 22, line 30). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply allowing an end user mailer to access the tracking information stored in the vendor database of Montgomery et al.; allowing multiple parties access to information in a database was well-known to one of ordinary skill in the art at the time of Applicants' invention). In combination, each element merely would have performed the same function as it did separately (Montgomery et al.'s elements would still be providing a unique tracking identifier to a mail piece; Baker et al.'s element would still allow for the communication of the service type for a mail piece; Watson's element would still allow for the tracking of more mailpieces; Leon's element would still allow a mailer to conveniently access tracking information concerning a mail piece). One of ordinary skill in the art would have recognized that the results of the combination were predictable (simply increasing access to the tracking database does not interfere with the other elements; nor does allowing the end user mailer to access the database in this context lead to any surprising results). Thus, the combination would have been obvious.

Montgomery et al. fails to disclose, for a search query for which no match is found, reporting to the particular user an indication that there is no matching information available for the particular search query. However, Examiner hereby takes Official Notice that that element/limitation was well-known to one of ordinary skill in the art at the time of Applicant's invention (search tools commonly returned messages such as "no matches found" when a search query turned up no results). It would have been obvious to one of ordinary skill in the art to modify the invention of Montgomery et al. such that, for a search query for which no match is found, it reports to the particular user an indication that there is no matching information available for the particular search query, as disclosed by Official Notice, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

29. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al. in further view of Watson in further view of Denman, U.S. Patent No. 5,737,729.

As per **Claim 6**, Montgomery et al., Baker et al., and Watson fail to disclose wherein the delivery address identifier is obtained from Internet-based postage delivery address information. Denman discloses wherein the delivery address identifier is obtained from Internet-based postage delivery address information (column 2, lines 27-45; column 5, lines 15-53; column 6, lines 14-52). It would have been obvious to one of

ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. as modified in the rejection for claim 5 such that the delivery address identifier is obtained from Internet-based postage delivery address information, as disclosed by Denman. Motivation is provided by Denman in that such a configuration allows for address searching (column 2, lines 27-45; column 5, lines 15-53; column 6, lines 14-52).

30. Claims 13 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Baker et al.

As per **Claim 13**, Montgomery et al. discloses:

- a method for tracking individual outbound first class mail pieces (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces);

- receiving a postage printing request from a particular customer user of a plurality of customer users using a computer-based postage provider, said postage printing request comprising a request for computer-based postage indicia for mailing a particular first class mail piece to a delivery address, wherein the request from the particular user to mail the particular first class mail piece comprises an indication by the particular user to provide tracking of the particular first class mail piece (Figures 19 and 22; paragraph [0089]; paragraphs [0090]-[0093]; users request postal indicia from postal

vendors; postal indicia contain tracking IDs; request is thus at least an implicit indication by user to provide tracking; invention may be applied to first class mail pieces);

- determining a delivery address identifier corresponding to the delivery address (paragraph [0004]; paragraphs [0087]-[0088]; may include POSTNET bar code, which identifies delivery address);

- formulating a next available first class mail piece identifier that would trackably identify the particular first class mail piece during a particular period of time, said first class mail piece identifier comprising a trackable combination of: a next available mailing subscriber identifier corresponding to an authorization to the computer-based postage provider by a governmental postal authority for the computer-based postage provider to generate for customer users of the computer-based postage provider, machine-readable, graphic symbologies representing tracking identifiers for first class mail pieces, a next available mailing identifier, and the delivery address identifier corresponding to the delivery address (Figures 19 and 22; paragraph [0004]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0104]; vendor ID [described as possibly part of a “Device ID”] is assigned by USPS; invention may be applied to first class mail pieces; mailing subscriber identifier is vendor ID; ID is a tracking ID; mailing identifier is user account number plus piece count [or ascending register]; vendor ID plus user account number plus piece count [or ascending register] is to be unique over a period of time, thereby allowing tracking; may include POSTNET bar code, which identifies delivery address);

encoding the next available first class mail piece identifier as a machine-readable graphic symbology (Figure 19; paragraphs [0087]-[0088]; paragraph [0089]; paragraph [0146]);

- storing an association between the particular customer user and the next available first class mail piece identifier (paragraph [0089]; paragraphs [0190]-[0194]; user account number that is part of the tracking ID identifies a particular user).

Montgomery et al. fails to disclose wherein the tracking identifier includes the destination tracking service type. Baker et al. discloses wherein the tracking identifier includes the destination tracking service type (paragraph [0002]; paragraph [0020]; paragraph [0028]; first two digits of PLANET code is service type). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the tracking identifier includes the destination tracking service type, as disclosed by Baker et al. Motivation is provided by Baker et al. in that the service type indicates whether an origin CONFIRM service or a destination CONFIRM service is desired (paragraph [0002]; paragraph [0020]; paragraph [0028]).

As per **Claim 15**, Montgomery et al. further discloses wherein the machine-readable graphic symbology comprises a one-dimensional bar-code (Figures 20 and 21; paragraph [0146]).

As per **Claim 16**, Montgomery et al. further discloses said method further comprising: responding to an indication by the particular customer user to print the machine readable graphic symbology by transmitting for printing the machine-readable graphic symbology (paragraph [0095]).

As per **Claim 17**, Montgomery et al. further discloses said method further comprising: generating for printing, computer-based postage indicia in accordance with the postage printing request (paragraph [0133]).

31. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al.

As per **Claim 21**, Montgomery et al. fails to disclose wherein the computer-based postage indicia is formatted for printing on a first label and wherein the first class mail piece tracking identifier is formatted for printing on a second label. However, that element/limitation was well-known to one of ordinary skill in the art at the time of Applicants' invention (two labels are often used in the corner and center of envelopes, for example). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the computer-based postage indicia is formatted for printing on a first label and the first class mail piece tracking identifier is formatted for printing on a second label, as was well-known to one of ordinary skill in the art at the time of Applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the

time of Applicants' invention that tracking information is sometimes placed near the address information in the center of an envelope instead of near the postage indicium in the corner of the envelope.

As per **Claim 22**, Montgomery et al. fails to disclose wherein the computer-based postage indicia and the first class mail piece tracking identifier are formatted for printing on an envelope. However, that element/limitation was well-known to one of ordinary skill in the art at the time of Applicants' invention (postal meters often can print on envelopes or labels). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the invention of Montgomery et al. such that the computer-based postage indicia and the first class mail piece tracking identifier are formatted for printing on an envelope, as was well-known to one of ordinary skill in the art at the time of Applicants' invention. Motivation is provided in that it was well-known to one of ordinary skill in the art at the time of Applicants' invention that envelopes and labels may each be preferred in different circumstances.

32. Claims 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery et al. in view of Leon.

As per **Claim 23**, Montgomery et al. discloses:

- a method for retrieving a trackable first class mail piece identifier using a computer-based postage system (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraphs [0190]-[0194];

ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces; system uses computers);

- retrieving, from a plurality of electronic first class mail piece identifier representations presented by a governmental postal authority, an electronic first class mail piece identifier representation corresponding to a scanned machine-readable barcode that matches a particular first class mail piece identifier that trackably identifies a particular first class mail piece during a particular period of time and that corresponds to a particular customer user of a plurality of customer users of the computer-based postage system, said particular first class mail piece identifier generated by the computer-based postage system according to an authorization by the governmental postal authority to a computer-based postage provider associated with the computer-based postage system, to create for customer users of the computer-based postage system, machine-readable, barcodes for tracking first class mail pieces (Figures 19 and 22; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraphs [0190]-[0194]; ID is a tracking ID; does not exclude envelope mail; tracking numbers may be added to first class mail in the future; invention may be applied to first class mail pieces).

Montgomery et al. fails to disclose a postage vendor reporting to a display device in communication with a client computer corresponding to the particular customer user, a set of tracking information associated with the electronic first class mail piece identifier representation. Leon discloses a postage vendor reporting to a display device in

communication with a client computer corresponding to the particular customer user, a set of tracking information associated with the electronic first class mail piece identifier representation (Figure 1; column 4, lines 1-55; column 8, lines 21-43; column 14, lines 26-47; column 21, line 19, through column 22, line 30). Therefore, the prior art included each element claimed although not necessarily in a single reference. One of ordinary skill in the art could have combined the elements as claimed by known methods (this is simply allowing an end user mailer to access the tracking information stored in the vendor database of Montgomery et al.; allowing multiple parties access to information in a database was well-known to one of ordinary skill in the art at the time of Applicants' invention). In combination, each element merely would have performed the same function as it did separately (Montgomery et al.'s elements would still be providing a unique tracking identifier to a mail piece; Leon's element would still allow a mailer to conveniently access tracking information concerning a mail piece). One of ordinary skill in the art would have recognized that the results of the combination were predictable (simply increasing access to the tracking database does not interfere with the other elements; nor does allowing the end user mailer to access the database in this context lead to any surprising results). Thus, the combination would have been obvious.

As per **Claim 26**, Montgomery et al. further discloses accessing a plurality of electronic mail piece representations presented by the postal authority, each electronic mail piece representation of the plurality of electronic mail piece representations corresponding to a machine sensing of a machine-readable graphic symbology created

in accordance with the authorization by the postal authority, and each electronic mail piece representation comprising an indication of a corresponding tracking identifier and a corresponding set of information regarding a status of a respective first class mail piece in a mail stream processed by the postal authority; saving in a computer-accessible memory, each electronic mail piece representation with the corresponding tracking identifier and the corresponding set of information regarding the status of the respective first class mail piece (Figures 19 and 22; paragraphs [0087]-[0088]; paragraphs [0190]-[0194]). Montgomery et al. fails to disclose searching the computer-accessible memory for a stored tracking identifier that matches the tracking identifier that trackably corresponds to the particular first class mail piece; for a match between a stored tracking identifier and the tracking identifier that trackably corresponds to the particular first class mail piece, reporting to the particular customer user, at least a portion of the corresponding set of information regarding the status of the particular first class mail piece. Leon discloses searching the computer-accessible memory for a stored tracking identifier that matches the tracking identifier that trackably corresponds to the particular first class mail piece; for a match between a stored tracking identifier and the tracking identifier that trackably corresponds to the particular first class mail piece, reporting to the particular customer user, at least a portion of the corresponding set of information regarding the status of the particular first class mail piece (Figure 1; column 4, lines 1-55; column 8, lines 21-43; column 14, lines 26-47; column 21, line 19, through column 22, line 30). It would have been obvious to one of ordinary skill in the art to modify the invention of Montgomery et al. such that it searches the computer-

accessible memory for a stored tracking identifier that matches the tracking identifier that trackably corresponds to the particular first class mail piece; and, for a match between a stored tracking identifier and the tracking identifier that trackably corresponds to the particular first class mail piece, reports to the particular customer user, at least a portion of the corresponding set of information regarding the status of the particular first class mail piece, as disclosed by Leon, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Montgomery et al. fails to disclose, for a search query for which no match is found, reporting to the particular user an indication that there is no matching information available for the particular search query. However, Examiner hereby takes Official Notice that that element/limitation was well-known to one of ordinary skill in the art at the time of Applicant's invention (search tools commonly returned messages such as "no matches found" when a search query turned up no results). It would have been obvious to one of ordinary skill in the art to modify the invention of Montgomery et al. such that, for a search query for which no match is found, it reports to the particular user an indication that there is no matching information available for the particular search query, as disclosed by Official Notice, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

33. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. in view of Montgomery et al.

As per **Claim 24**, Baker et al. discloses:

- a method for tracking individual outbound mail pieces using a computer-based postage system (paragraph [0002]; paragraphs [0004]-[0010]; paragraph [0020]; paragraph [0028]);

- assigning a composite confirm identifier to a particular mail piece according to input by a particular mailer of a plurality of mailers that are customers of the computer-based postage system, wherein said composite confirm identifier trackably identifies the particular mail piece during a particular period of time (paragraph [0002]; paragraphs [0004]-[0010]; paragraph [0020]; paragraph [0028]; paragraph [0035]);

- relating the composite confirm identifier for the particular mail piece to the particular mailer (paragraph [0002]; paragraphs [0004]-[0010]; paragraph [0020]; paragraph [0028]);

- receiving a scanning event about the composite confirm identifier scanned by the postal authority (paragraphs [0005]-[0007]; paragraph [0025]);

- reporting the scanning event to the particular mailer (paragraphs [0005]-[0007]; paragraph [0025]).

Baker et al. fails to disclose wherein mail pieces are first class mail pieces; wherein the tracking identifier is assigned according to an authorization by a postal authority to a computer-based postage provider associated with the computer-based

postage system, to create for mailers that are customers of the computer-based postage system, machine-readable, barcodes for tracking mail pieces; encoding the tracking identifier as a machine-readable barcode according to the authorization by the postal authority. Montgomery et al. discloses wherein mail pieces are first class mail pieces; wherein the tracking identifier is assigned according to an authorization by a postal authority to a computer-based postage provider associated with the computer-based postage system, to create for mailers that are customers of the computer-based postage system, machine-readable, barcodes for tracking mail pieces; encoding the tracking identifier as a machine-readable barcode according to the authorization by the postal authority (Figures 19 and 22; paragraph [0004]; paragraphs [0024]-[0025]; paragraph [0032]; paragraphs [0087]-[0088]; paragraph [0089]; paragraphs [0090]-[0093]; paragraph [0146]). It would have been obvious to one of ordinary skill in the art to modify the invention of Baker et al. such that mail pieces are first class mail pieces; the tracking identifier is assigned according to an authorization by a postal authority to a computer-based postage provider associated with the computer-based postage system, to create for mailers that are customers of the computer-based postage system, machine-readable, barcodes for tracking mail pieces; and the invention encodes the tracking identifier as a machine-readable barcode according to the authorization by the postal authority, as disclosed by Montgomery et al., since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

34. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

35. **Examiner's Note:** Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN ERB whose telephone number is (571)272-7606. The examiner can normally be reached on Mondays through Fridays, 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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